

REMARKS

In the Office Action¹, the Examiner rejected claims 1 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,930,446 to Kanda ("*Kanda*"); rejected claims 1 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,094,522 to Ito et al. ("*Ito*"); rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Kanda* in view of U.S. Patent No. 6,064,793 to Furuyama ("*Furuyama*"); objected to claims 3-8 as being dependent upon a rejected base claim; and allowed claims 9-15 and 17.

Applicants have amended claims 1, 2, and 16 and added new claim 18. Claims 1-18 are pending.

Applicants respectfully traverse the rejection of claims 1 and 16 under 35 U.S.C. § 102(e) as anticipated by *Kanda*. In order to properly establish that *Kanda* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites an editing apparatus including, for example:

designation means for designating an editing position of the coded data;

evaluation means for evaluating a playback state according to a playback standby time required to start playback after an instruction to play back the coded data from the editing position designated by said designation means;

(emphasis added). The Examiner states that *Kanda* “fails to teach the evaluation means outputs, as the evaluation result, a playback standby time required to start playback” (Office Action at page 4). *Kanda* discloses an edition system comprising a main recording and reproducing apparatus comprising input/output means and recording and reproducing means (col. 1, lines 15-41). *Kanda* does not teach an “evaluation means for evaluating a playback state according to a playback standby time required to start playback after an instruction to play back the coded data from the editing position designated by said designation means”, as recited in claim 1.

Accordingly, *Kanda* cannot anticipate claim 1. Independent method claim 16, while of different scope, recites limitations similar to those of apparatus claim 1 and is thus allowable over *Kanda* for at least the same reasons discussed above in regard to claim 1.

Applicants respectfully traverse the rejection of claims 1 and 16 under 35 U.S.C. § 102(e) as anticipated by *Ito*.

Ito discloses a “broadcasting system of a television broadcasting station, audio and/or video data recording and reproduction apparatus” (col. 4, lines 7-9). “[S]torage device 26 records and reproduces the noncompressed audio and/or video data” and “processing circuit 602 mixes the audio and/or video data” (col. 13, lines 15-16 and 33-

34). However, *Ito* does not teach an “evaluation means for evaluating a playback state according to a playback standby time required to start playback after an instruction to play back the coded data from the editing position designated by said designation means”, as recited in claim 1.

Accordingly, *Ito* cannot anticipate apparatus claim 1 or method claim 16.

Applicants respectfully traverse the rejection of claim 2 under 35 U.S.C. § 103(a). The Examiner relies on column 10 of *Furuyama* for allegedly teaching “a[n] evaluation means for outputting a playback standby time (waiting time) required to start playback outputting after an instruction to play back” (Office Action at page 4). Applicants respectfully disagree.

This passage of *Furuyama* discloses a point on the magnetic tape that is “a point preceding the cut-in timing by a length of time necessary before the travel of the tape is stabilized to give an adequate state of reproduction [and] is displayed in a blinking manner in such a manner as -:--:--” (col. 10, lines 1-7). A count value “nSec” indicates the cut-in timing point on the tape, and a flow of the operation in a state of waiting for settling action on the count value of a cut-out point is indicated by “a blinking display of -:--:--” (col. 10, lines 24-30 and Fig. 6B).

The blinking display, of *Furuyama*, shows that the flow of operation is in a state of waiting (col. 11, lines 26-27). This display is not used in evaluating a playback state. Therefore, *Furuyama* does not teach an “evaluation means for evaluating a playback state according to a playback standby time required to start playback after an instruction to play back the coded data from the editing position designated by said designation means”, as recited in claim 1.

Accordingly, *Kanda* and *Furuyama* fail to establish a *prima facie* case of obviousness with respect to claim 2.

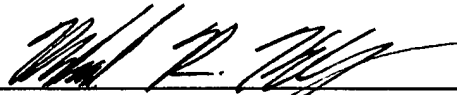
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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